



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/003,098	01/06/98	KNOWLTON	E 16904-727

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EXAMINER

SHAY, D

ART UNIT	PAPER NUMBER
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3739

DATE MAILED:

09/27/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/003098

Applicant(s)

Knowlton

Examiner

L. Shy

Group Art Unit

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on May 28, 1999
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-62 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-68 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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The rejections set forth in the previous Office Action are hereby repeated.

It is note that applicant has filed Terminal Disclaimers to overcome the various double patenting rejections applied to the claims. As the Patent Office has been unable to review these disclaimers to determine whether or not they are proper, the rejections are maintained until such time as the Terminal Disclaimer can be reviewed.

Applicant argues that claims 3-8 and 19 provide further refinements of the fifth step of the method.” The examiner notes that in order to further limit a method, an apparatus must manipulatively affect the method. See Ex Parte Pfeiffer 782 OG 639 1962 CD 408. Thus defining the energy source does not manipulatively affect the claimed and disclosed method. The asserted existence of similar limitations in issued patents is noted, but has no bearing on the determination of definiteness of the instant claims, as each application must stand on it’s own merits.

Similarly regarding the apparatus claims, while there is nothing inherently wrong with describing a limitations in functional terms, the functional description must be sufficiently precise and not so vague as to be meaningless as here. Further the function must be positively recited. Reciting an apparatus as “configured to deliver...” does not provide clear, positive functional recitation.

Regarding the rejection under 102, applicant argues that Eggers (909) teaches away from the use of electrically conducting fluid to deliver energy. The Examiner respectfully submits the applicant has misread the Eggers (909) disclosure. As clearly stated in column 6 lines 55-63 and

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column 7 lines 15-22 wherein it is disclosed that Eggers seeks to limit the power to a particular electrode when the impedance between the particular electrode and the common electrode is reduced. Clearly, since Eggers (909) anticipates the presence of conductive fluid like normal saline at the operative site, it is given that this fluid is delivered there. Eggers does not contemplate halting the delivery of energy to the target tissue through such liquid. Only the short ~~circuits~~ ^{circuits} of the active electrodes with the common electrode by saline is taught to be avoided, ² but devices such as those in figure 3 and 12 of Eggers (909) still deliver energy through the saline to the tissue. While Eggers (909) does not teach applicant's method, the Examiner notes that the device of Eggers is "configured" to deliver the lower energy levels recited or implied by applicants disclosure and claims and ^{thus} ~~the~~ fulfills the apparatus claim language. ²

Regarding the rejection under the combination of Neeffe and Sand, applicant argues that because Neeffe does not teach the method as claimed, one having ordinary skill would not combine Neeffe and Sand. The Examiner notes that for the purposes of the combination, Neeffe is only used to show the equivalence in the art of using various form of electromagnetic energy to provide heating. Applicant has shown no reasons and Examiner can see none that would prevent one having ordinary skill in the art from making the combination as set forth in the rejection

Applicant's arguments filed May 28, 1989 have been fully considered but they are not persuasive.

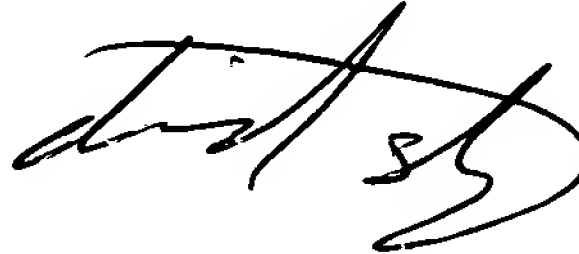
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to David Shay at telephone number (703) 308-2215.

David Shay:bhw
September 1, 1999



DAVID M. SHAY
PRIMARY EXAMINER
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